Trademark Creation

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This checklist organizes the major steps in the trademark creation process, addressing both business and legal points of view.

A. Assemble the Branding and Trademark Clearance Team

1. Check off below all who need to be in the room:

__ Product development

__ Marketing

__ Advertising

__ Legal
   __ In-house
   __ Outside

__ Website Design

__ Domain Name Management

__ Finance

__ International Business Representatives
B. Scope of the Brand

1. Check off all intended purposes of the trademark:

   __ Company name
   __ House mark
   __ Lead product
   __ Secondary product/product line extension
   __ Product feature/ingredient
   __ Product accessory

2. ___ Lifespan: how long is the mark likely to be used?

3. ___ Geography: where is the mark likely to be used?

C. Consider Positioning

1. Where does this brand fit in the market?

   __ Define the target customers.
   __ Define the anticipated channels of trade.
   __ Define the “personality” of the brand.

2. Check off all consumer needs and desires the brand will serve:

   __ Prestige
   __ Value
   __ Credibility
   __ Comfort
   __ Safety
   __ Health
   __ Other
3. List characteristics of the new brand that serve these needs and desires better than others in the market:

- Design
- Quality/Safety
- Ease of use
- Price
- Other

4. List facts that substantiate claims.

D. Consider Distinctiveness

- Market: stands out in the crowd
- Legal: inherently distinctive (fanciful, arbitrary, suggestive) v. merely descriptive
- Regulatory considerations: do any special regulations apply to selection or use of marks for the proposed goods/services?

E. Brainstorm

1. Generate a list of ideas for proposed marks
   - Existing words
   - Made-up words
   - Names
   - Slogans
   - Design elements, fonts
   - Colors
   - Sounds
   - 3-D
F. Winnow

1. Refine list of “contenders.”
   __ Eliminate ideas that don’t support the desired positioning.
   __ Compare to competitors’ marks.
   __ Search Google, Facebook, other social media to survey other possible users/uses/connotations.
   __ Research possible meanings in other languages.
   __ Determine availability of relevant domain names.
   __ Conduct preliminary trademark clearance of leading three to five contenders (see “Trademark Clearance Checklist”).

2. __ Evaluate findings.

3. __ Choose mark.

G. Registration Strategy

1. For trademark applications, consider:
   __ Format of mark
      __ Standard characters
      __ Design only
      __ Combined word and design marks
      __ Non-traditional
   __ Jurisdictions
   __ Proposed goods and services
   __ Bases for registration
      __ Proposed use
      __ Use
      __ Priority or seniority
2. For domain names, check off all that may apply below:

  __ Global Top Level Domains
    __ .com
    __ .net
    __ .org
    __ .edu
    __ Custom gTLD
    __ Others

  __ Regional or Country code domains

  __ Variations of the name

  __ Translations and transliterations of the name

  __ Non-ASCII character versions of the name

3. For company names, check off all that may apply below:

  __ Country, province, state of incorporation

  __ Regulations concerning names, such as requirements to include “Inc.” or “Co.”

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